

Note

Sovereign Immunity to Copyright Infringement Actions after *Atascadero*

I. INTRODUCTION

The Constitution vests the power to issue letters of patent and copyright with Congress.¹ Congress has, from time to time, passed and revised various copyright statutes,² culminating with the passage of the Copyright Act of 1976 (1976 Act).³ These statutes have provided authors and artisans with some level of protection against the unauthorized use of their expressions. A recent Supreme Court opinion,⁴ not involving a copyright issue, however, threatens to open the door to the plundering of this property right at the hands of our own elected officials.

In *Atascadero State Hospital v. Scanlon*,⁵ a case involving eleventh amendment immunity to federal employment discrimination laws, the Supreme Court has encouraged the dismissal of copyright infringement actions against state actors by allowing the states to more readily rely on the defense of eleventh amendment immunity. In the most recent copyright cases, the lower courts have cited the language used in *Atascadero* as being applicable to copyright infringement actions against state actors.⁶ In fact, one court has interpreted *Atascadero* as *mandating* dismissal of infringement actions against state actors,⁷ even though it recognized that this interpretation of *Atascadero* would "allow states to violate the federal copyright laws with virtual impunity."⁸ Careful analysis of the *Atascadero* opinion, however, together with a review of relevant eleventh amendment immunity cases,⁹ reveals a more consistent and logical line of reasoning that will permit the lower courts to give

1. U.S. CONST. art. I, § 8, cl. 8 [hereinafter Patent and Copyright Clause].

2. On May 31, 1790, Congress passed an act "for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned." ch. 15, 1 Stat. 124 (1790). On April 29, 1802, the benefits of the 1790 act were extended to "arts of designing, engraving, and etching historical and other prints." ch. 36, 2 Stat. 171 (1802).

The 1790 and 1802 acts were repealed when Congress adopted a new copyright statute on February 3, 1831. Among other changes, the new statute extended copyright protection to musical works, ch. 16, 4 Stat. 436 (1831). Copyright protection was further extended to cover dramatic compositions on August 18, 1856, ch. 169, 11 Stat. 138 (1856), and to photographs and negatives on March 3, 1865, ch. 126, 13 Stat. 540 (1865).

Congress made its second major revision of the copyright laws on July 8, 1870. In addition to revising and consolidating the existing copyright laws, the new act extended copyright protection to paintings, drawings, statues, and other works of fine art, ch. 230, 16 Stat. 198 (1870).

The last major revision of the copyright laws prior to the Copyright Act of 1976 was the Copyright Act of 1909, ch. 320, 35 Stat. 1075.

3. Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 110-914 (1982 & Supp. IV 1986)).

4. *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234 (1985).

5. *Id.*

6. See, e.g., *BV Eng'g v. University of Cal.*, Los Angeles, 657 F. Supp. 1246 (C.D. Cal. 1987), *aff'd*, 858 F.2d 1394 (9th Cir. 1988); *Richard Anderson Photo. v. Radford Univ.*, 633 F. Supp. 1154 (W.D. Va. 1986), *aff'd sub nom.*, *Richard Anderson Photo. v. Brown*, 852 F.2d 114 (4th Cir. 1988); *Woelffer v. Happy States of Am.*, 626 F. Supp. 499 (N.D. Ill. 1985).

7. See, e.g., *BV Eng'g v. University of Cal.*, Los Angeles, 858 F.2d 1394 (9th Cir. 1988).

8. *Id.* at 1400.

9. See, e.g., *Garcia v. San Antonio Metro. Transp. Auth.*, 469 U.S. 528 (1985) (involving the tenth amendment); *Fitzpatrick v. Bitzer*, 427 U.S. 445 (1976); *Edelman v. Jordan*, 415 U.S. 651 (1974); *In re McVey Trucking*, 812 F.2d 311 (7th Cir. 1987), *cert. denied*, *Edgar v. McVey Trucking*, 108 S. Ct. 227 (1987).

effect to the intention of Congress to subject the individual states to suits for copyright infringement, without upsetting the delicate balance between state and federal powers.

This Note will focus on a discussion of the limitations placed on Congress to abrogate the states' eleventh amendment immunity. A comparison between Congress' power under the fourteenth amendment and Congress' plenary powers will reveal that Congress can abrogate the states' eleventh amendment immunity under any of its plenary grants of power. The Note will further argue that the lower courts have adopted an overly restrictive reading of the *Atascadero* opinion and, in doing so, are frustrating the clear intentions of Congress, leaving copyright owners without a remedy to protect their property rights whenever the infringer is a state actor.

II. THE EARLY CASES

Because there are few authoritative cases dealing with the issue of sovereign immunity¹⁰ to copyright infringement actions, the area has received little attention. As a result, the courts that have recently been asked to decide this issue have had to do so without the benefit of significant precedent.

The copyright cases prior to *Atascadero* show a mixed interpretation of the effect of the eleventh amendment on copyright infringement actions. *Wihtol v. Crow*¹¹ was one of the earliest cases squarely dealing with the issue of sovereign immunity to copyright infringement actions. In *Wihtol*, the defendant, Crow, copied a song for which the plaintiff, Wihtol, held a valid copyright.¹² Crow incorporated this song into a new arrangement and then distributed copies of the derivative work to the high school choir of the Clarinda, Iowa, School District, which he directed.¹³

Wihtol brought suit against both Crow and the school district employing Crow. The Eighth Circuit, relying on an earlier Supreme Court opinion in *Ex parte New York*,¹⁴ which dealt with eleventh amendment immunity, although not in a copyright context, held that a suit against the State of Iowa for copyright infringement "clearly could not be maintained because of the Eleventh Amendment to the Constitution of the United States."¹⁵ Because the school district was an instrumentality of the State of Iowa, and Wihtol was seeking a judgment that would be payable out of public funds, the Eighth Circuit ruled that it lacked jurisdiction.¹⁶

10. "[The sovereign immunity] [d]octrine precludes [the] litigant from asserting an otherwise meritorious cause of action against a sovereign or a party with sovereign attributes unless [the] sovereign consents to suit. . . ." BLACK'S LAW DICTIONARY 1252 (5th ed. 1979).

The focus of this Note is the sovereign immunity doctrine as applied to the federal courts through the operation of the eleventh amendment: "The Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another state, or by Citizens or Subjects of any Foreign State." U.S. CONST. amend. XI.

11. 309 F.2d 777 (8th Cir. 1962), *reh'g denied*, (Jan. 5, 1963).

12. *Id.* at 778.

13. *Id.* at 778-79.

14. 256 U.S. 490 (1921) (In this case, involving a claim against the State of New York for damages caused by tugs operated by the state, the Court ruled that a state could not be sued by a private citizen in federal court without the state's consent.). *Id.* at 497.

15. *Wihtol*, 309 F.2d at 781.

16. *Id.* at 782.

The Ninth Circuit, in *Mills Music v. Arizona*,¹⁷ considered the *Wihtol* opinion. In *Mills Music*, the State of Arizona used a musical composition as the theme song to the 1971 Arizona State Fair without the copyright owner's permission.¹⁸ In discussing the eleventh amendment immunity defense, the court noted that the Patent and Copyright Clause was a grant of constitutional power that places inherent limitations on state sovereignty. Having failed to find any express intent of Congress to subject the individual states to the penalties of the copyright statute,¹⁹ the court nonetheless was convinced that the sweeping language of the statute,²⁰ taken in the context of the activity being regulated and the statute's legislative history,²¹ together with the fact that Congress had made the United States subject to the statute,²² implied that Congress had abrogated the states' eleventh amendment immunity.²³

The District Court for the Eastern District of Michigan criticized the *Mills Music* opinion in *Mihalek Corporation v. Michigan*.²⁴ In *Mihalek*, the plaintiff alleged copyright infringement by the State of Michigan in several elements of a tourism campaign.²⁵ As one defense, the state raised its eleventh amendment immunity.²⁶ Relying on a noncopyright case, *Edelman v. Jordan*,²⁷ where the Supreme Court had held that retrospective monetary damages were barred by the eleventh amendment,²⁸ the district court held that the eleventh amendment gave the state immunity from money damages when the award would be paid out of the state treasury.²⁹ The district court went further and stated in dicta that it felt "compelled to conclude that *Mills Music* was decided incorrectly,"³⁰ concluding that copyright owners did not deserve more protection under the 1976 Act than the plaintiffs deserved in *Edelman*.³¹ The Sixth Circuit affirmed the decision without reaching the eleventh amendment question.³²

*Johnson v. University of Virginia*³³ was the final case dealing with the issue of eleventh amendment immunity to copyright infringement to be decided prior to

17. 591 F.2d 1278 (9th Cir. 1979), *ovr'd* by BV Eng'g v. University of Cal., Los Angeles, 858 F.2d 1394 (9th Cir. 1988).

18. *Mills Music*, 591 F.2d at 1280.

19. *Id.* at 1285.

20. "The language of the statute is sweeping and without apparent limitation, suggesting that Congress intended to include states within the class of defendants." *Id.* at 1285.

21. *Id.* at n.8.

22. "Even the United States is liable for the infringement of a copyright, . . . to hold that Congress did not intend to include states within the class of defendants would lead to an anomalous construction of the statute at best." *Id.* See 28 U.S.C. § 1498 (1982).

23. *Mills Music*, 591 F.2d at 1285.

24. 595 F. Supp. 903 (E.D. Mich. 1985), *reh'g denied*, 630 F. Supp. 9 (E.D. Mich. 1985), *aff'd*, 814 F.2d 290 (6th Cir. 1987).

25. *Mihalek*, 595 F. Supp. at 904.

26. *Id.* at 905.

27. 415 U.S. 651 (1974). In *Edelman*, the respondent alleged that the State of Illinois was administering the Aid to the Aged, Blind, or Disabled program in a manner that violated the fourteenth amendment. *Id.* at 653.

28. *Id.* at 678.

29. *Mihalek*, 595 F. Supp. at 906.

30. *Id.* at 905.

31. *Id.* at 906.

32. *Mihalek Corp. v. Michigan*, 814 F.2d 290, 297 (6th Cir. 1987).

33. 606 F. Supp. 321 (W.D. Va. 1985).

Atascadero. In *Johnson*, the plaintiff alleged infringement of several photographic slides by the University of Virginia.³⁴

The district court analyzed both the *Mills Music* opinion and the opinion in *Wihtol*. Relying extensively on *Mills Music*, the district court held that the use of sweeping language in the 1976 Act was sufficient to indicate an intent on the part of Congress to abrogate the states' eleventh amendment immunity.³⁵ The district court dismissed *Wihtol* as "little more than a conclusory statement that the Eleventh Amendment bars suits against the states. . . ."³⁶ This assessment was based on the district court's conclusion that *Wihtol* "did not present a compelling case for addressing the issue of whether the states' Eleventh Amendment immunity was waived by the . . . 1909 [Copyright] Act."³⁷ The district court praised the opinion in *Mills Music* as "a thoughtful examination of the 1909 [Copyright] Act and the recent Supreme Court opinions concerning the Eleventh Amendment. . . ."³⁸

Although there were cases decided prior to *Atascadero* that dealt directly with the issue of eleventh amendment immunity to copyright infringement actions, the divergence in the results was significantly narrowed in later cases by the courts' application of the *Atascadero* opinion to copyright infringement actions.

III. THE *ATASCADERO* DECISION

The relatively unexamined issue of state liability for copyright infringement began to receive renewed attention in the wake of Justice Powell's opinion in *Atascadero State Hospital v. Scanlon*.³⁹ In *Atascadero*, the plaintiff, Scanlon, sued the Atascadero State Hospital and the California Department of Mental Health for employment discrimination, alleging a violation of section 504 of the Rehabilitation Act of 1973.⁴⁰

In a five to four opinion, the Court held that "Congress must express its intention to abrogate the Eleventh Amendment in unmistakable language in the statute itself"⁴¹ and "[a] general authorization for suit in federal court is not the kind of unequivocal statutory language sufficient to abrogate the Eleventh Amendment."⁴² Further, the Court refused to adopt the reasoning advanced by the Ninth Circuit in *Mills Music* that states can consent to be sued⁴³ by voluntarily

34. *Id.* at 322.

35. *Mills Music* was decided under the 1909 Copyright Act which used the term "any person." See ch. 320, 35 Stat. 1075 (1909). In contrast, the *Johnson* court was faced with interpreting the 1976 Copyright Act, which uses the term "anyone." See 17 U.S.C. § 501(a) (1982 & Supp. IV 1986).

Comparing the two copyright statutes, the *Johnson* court stated that "the 1976 Copyright Act is at least as sweeping, and probably more sweeping, than the language of the 1909 Act. . . ." *Johnson*, 606 F. Supp. at 324.

36. *Johnson*, 606 F.Supp. at 323.

37. *Id.* at n.1.

38. *Id.* at 323.

39. 473 U.S. 234 (1985).

40. *Id.* at 236.

41. *Id.* at 243.

42. *Id.* at 246.

43. *Mills Music v. Arizona*, 591 F.2d 1278, 1286 (9th Cir. 1979).

participating in federally sponsored programs.⁴⁴ Because the Rehabilitation Act did not "evinced an unmistakable congressional purpose,"⁴⁵ the Court held that federal courts lacked jurisdiction to entertain suits brought under the Rehabilitation Act against state actors by the operation of the eleventh amendment.⁴⁶

Recent lower court opinions, when addressing the issue of eleventh amendment immunity to copyright infringement actions, have focused on the "unmistakable language in the statute itself"⁴⁷ requirement of *Atascadero*. Equating their failure to find the 1976 Act's language "unmistakable" with the failure of the Court to find unmistakability in the language of the Rehabilitation Act, the lower courts have interpreted *Atascadero* as justifying dismissal of copyright infringement suits against state actors.⁴⁸

IV. IMMUNITY TO COPYRIGHT INFRINGEMENT ACTIONS AFTER *ATASCADERO*

A. *The Recent Cases*

While the courts in *Wihitol* and *Mills Music*, both decided before *Atascadero*, differed in their analysis and result, the cases decided after *Atascadero* have been virtually unanimous in their application of the *Atascadero* test to deny abrogation of the states' eleventh amendment immunity under the 1976 Act.

Decided almost immediately after *Atascadero*, *Cardinal Industries v. Anderson Parrish Association*⁴⁹ involved the alleged infringement of copyrighted architectural plans by the University of South Florida.⁵⁰ The State of Florida raised the eleventh amendment as a defense.⁵¹ The district court, without discussing the *Atascadero* opinion, the conflicting case law, or the statutes that it claimed to have reviewed,⁵² held that the state had not waived its immunity and that the immunity had not been abrogated by Congress.⁵³ The state's motion to dismiss was, therefore, granted by the court.⁵⁴ The decision was later affirmed by the Eleventh Circuit without discussion.⁵⁵

The *Atascadero* test was first applied to a copyright infringement action in *Woelffer v. Happy States of America, Inc.*⁵⁶ In *Woelffer*, The Illinois Department of

44. *Atascadero*, 473 U.S. at 247.

45. *Id.*

46. *Id.*

47. *Id.* at 243.

48. See, e.g., *BV Eng'g v. University of Cal.*, Los Angeles, 858 F.2d 1394 (9th Cir. 1988).

49. No. 83-1038-Civ-T-13, slip op. (M.D. Fla. Sept. 6, 1985), *aff'd*, No. 86-3354, slip op. (11th Cir. Jan. 27, 1987) (per curiam) (as cited in Note, *Copyright Infringement and the Eleventh Amendment: A Doctrine of Unfair Use?*, 40 VAND. L. REV. 225, 251 n.196 (1987)).

50. See Brief of Appellant, at 2, *Cardinal Indus. v. Anderson Parrish Ass'n*, No. 86-3354, slip op. (11th Cir. Jan. 27, 1987) (as cited in Note, *Copyright Infringement and the Eleventh Amendment: A Doctrine of Unfair Use?*, 40 VAND. L. REV. 225, 251 n.197 (1987)).

51. *Cardinal Indus. v. Anderson Parrish Ass'n*, No. 83-1038-Civ-T-13, slip op. at 2-3 (M.D. Fla. 1985) (as cited in Note, *Copyright Infringement and the Eleventh Amendment: A Doctrine of Unfair Use?*, 40 VAND. L. REV. 225, 252 (1987)).

52. *Id.*

53. *Id.* at 5.

54. *Id.*

55. *Cardinal Indus. v. Anderson Parrish Ass'n*, No. 86-3354, slip op. (11th Cir. Jan. 27, 1987), *cert. denied*, *Cardinal Indus., Inc. v. King*, 108 S. Ct. 88 (1987).

56. 626 F. Supp. 499 (N.D. Ill. 1985).

Commerce and Community Affairs (DCCA) brought a declaratory judgment action seeking a declaration that its advertising slogan did not violate the copyright owned by Happy States.⁵⁷ Happy States answered by filing a counterclaim for copyright infringement and sought both monetary and injunctive relief.⁵⁸ DCCA raised the eleventh amendment as a defense to the counterclaim.⁵⁹

The district court first determined that DCCA had partially waived its eleventh amendment immunity by initiating the action itself in federal court.⁶⁰ However, after a brief and less than clear discussion, the district court held that this waiver was not sufficient to allow either monetary damages or an injunction from further infringement.⁶¹

The district court then discussed the argument raised by Happy States that by enacting the 1976 Act, Congress had abrogated eleventh amendment immunity to copyright infringement actions.⁶² Admitting that the sweeping language of the 1976 Act "arguably includes states within the class of copyright and trademark infringers,"⁶³ the district court nonetheless held that under the "watershed principle enunciated in *Atascadero*,"⁶⁴ the broad language of the 1976 Act alone was "not enough to abrogate sovereign immunity."⁶⁵ Borrowing heavily from the language in *Atascadero*, the district court held that in enacting the 1976 Act, Congress failed to "express its intention to abrogate the Eleventh Amendment in unmistakable language in the statutes themselves. . . ."⁶⁶

*Richard Anderson Photography v. Radford University*⁶⁷ was the next occasion when a court used the *Atascadero* test to deny abrogation under the 1976 Act. The state actor in *Anderson* was a Virginia public university.⁶⁸ The plaintiff, Anderson, brought suit against Radford alleging infringement of the copyrights in several photographs owned by Anderson.⁶⁹

In *Anderson*, the district court eliminated the issue of congressional intent from its consideration by holding that "Congress does not have the power to abrogate States' Eleventh Amendment immunity without their consent unless it acts pursuant to § 5 of the Fourteenth Amendment."⁷⁰ Because the 1976 Act had been enacted

57. *Id.* at 501.

58. *Id.*

59. *Id.*

60. *Id.* at 502.

61. *Id.* at 503.

62. *Id.* at 503-05.

63. *Id.* at 504.

64. *Id.*

65. *Id.*

66. *Id.*

67. 633 F. Supp. 1154 (W.D. Va. 1986).

68. *Id.* at 1155.

69. *Id.* at 1156.

70. *Id.* at 1158. The fourteenth amendment provides:

1. No State shall make or enforce any law which shall abridge the privileges and immunities of the citizens of the United States; nor shall any State deprive any person of life, liberty, or property, without due process of law;

. . . .

5. The Congress shall have power to enforce, by appropriate legislation, the provisions of this article.

U.S. CONST. amend. XIV.

under Congress' article I powers, and not under its fourteenth amendment powers, the court concluded that it was unnecessary to examine the congressional intent behind the 1976 Act and instead focused its discussion on the issue of a waiver of immunity by Virginia.⁷¹ Although this limitation of Congress' article I powers can be inferred from *Atascadero*,⁷² other courts have not been so readily disposed to seize upon this inference as the sole basis of their holdings.⁷³

The district court, finding no evidence of an express waiver,⁷⁴ was not willing to imply a waiver.⁷⁵ Although the district court found the argument advanced in *Mills Music* and *Johnson* persuasive, it held that the *Atascadero* test demanded an "unequivocal indication" of consent to suit in federal court.⁷⁶ Having found no such indication, the district court dismissed the action.⁷⁷

On appeal, the Fourth Circuit Court of Appeals affirmed the district court's dismissal of the suit, but took a different approach.⁷⁸ Focusing on the language of the 1976 Act, the Fourth Circuit, strictly construing *Atascadero*, held that the language of the 1976 Act does not "clearly and unequivocally indicate Congress' intent to create a cause of action . . . enforceable against the states in federal court. . . ."⁷⁹

In *BV Engineering v. University of California, Los Angeles*,⁸⁰ the plaintiff alleged infringement of seven copyrighted software programs and associated documents owned by BV.⁸¹ As a defense, UCLA raised eleventh amendment immunity.⁸² Approaching the question of immunity to copyright infringement actions from a different perspective than that of the court in *Anderson*,⁸³ the district court in *BV Engineering* concluded that Congress "may abrogate the state's immunity to suit pursuant to any of its plenary powers."⁸⁴ Under this interpretation of congressional power, the district court was free to look for either a waiver of immunity by the state, or an indication of congressional intent to abrogate the state's immunity in the 1976 Act.

Although agreeing with the logic of the *Mills Music* decision that congressional intent to abrogate the eleventh amendment immunity is implicit in the 1976 Act, the district court held that the "emphatic"⁸⁵ demand in the *Atascadero* opinion for an

71. *Anderson*, 633 F. Supp. at 1158-60.

72. *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 247 (1985) ("[W]e have decided today that the Rehabilitation Act does not evince an unmistakable congressional purpose, pursuant to § 5 of the Fourteenth Amendment, to subject unconsenting States to the jurisdiction of the federal courts.").

73. See, e.g., *infra* notes 83-84 and accompanying text.

74. *Anderson*, 633 F. Supp. at 1159.

75. *Id.* at 1160.

76. *Id.* at 1159 (quoting *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 238 n.1 (1985)).

77. *Id.* at 1161.

78. *Richard Anderson Photo. v. Brown*, 852 F.2d 114, 116-22 (4th Cir. 1988).

79. *Id.* at 120.

80. 657 F. Supp. 1246 (C.D. Cal. 1987), *aff'd*, 858 F.2d 1394 (9th Cir. 1988).

81. *Id.* at 1247.

82. *Id.*

83. *Richard Anderson Photo. v. Radford Univ.*, 633 F. Supp. 1154 (W.D. Va. 1986).

84. *BV Eng'g*, 657 F. Supp. at 1248 (quoting *In re McVey Trucking*, 812 F.2d 311, 323 (7th Cir. 1987)).

85. *Id.* at 1250.

express statement of congressional intent to abrogate the eleventh amendment immunity in the statute itself demanded dismissal of the suit.⁸⁶

On appeal, the Ninth Circuit agreed with the district court. Stating that the Supreme Court had issued a "mandate" that the eleventh amendment immunity be abrogated only when "Congress has included in the statute unequivocal and specific language indicating an intent to subject states to suit in federal court,"⁸⁷ the Ninth Circuit concluded that *Mills Music* had been overruled.⁸⁸

In the most recent case to address the question of eleventh amendment immunity to copyright infringement actions, *Lane v. First National Bank of Boston*,⁸⁹ the plaintiff brought suit against the Commonwealth of Massachusetts, alleging infringement of her copyright in a computerized data base.⁹⁰ The Commonwealth filed a motion for summary judgment based in part on the defense of eleventh amendment immunity.⁹¹

The district court held that the 1976 Act failed to provide the "unmistakable language required by *Atascadero*."⁹² However, the district court focused solely upon the term "anyone" as used in the 1976 Act⁹³ and found the term "insufficient to include the Commonwealth."⁹⁴

B. Summary of the Recent Cases

While the recent cases have been uniform in their application of the eleventh amendment immunity to bar copyright infringement actions against state actors, their reasoning has varied. Both the district court in *BV Engineering* and the *Woelffer* court held that the language of the 1976 Act was broad enough to include the individual states within its scope, and hence, abrogate the eleventh amendment immunity.⁹⁵ However, both courts further held that the provisions of the 1976 Act were not specific enough to withstand the *Atascadero* test for abrogation.⁹⁶ On the other hand, the district court in *Anderson* held that the *Atascadero* opinion recognized congressional abrogation of the eleventh amendment immunity only when Congress specifically acts under section 5 of the fourteenth amendment.⁹⁷ Because the 1976

86. *Id.* at 1250-51.

87. *BV Eng'g v. University of Cal.*, Los Angeles, 858 F.2d 1394, 1400 (9th Cir. 1988).

88. *Id.* at 1397 n.1.

89. 687 F. Supp. 11 (D. Mass. 1988).

90. *Id.* at 13.

91. *Id.* at 12.

92. *Id.* at 14-15.

93. 17 U.S.C. § 501(a) (1982) ("anyone who violates any of the exclusive rights of the copyright owner . . .").

94. *Lane*, 687 F. Supp. at 14.

95. "In the copyright, trademark, and patent area, it seems reasonable that an intention to bind the States should be implied. . . ." *BV Eng'g v. University of Cal.*, Los Angeles, 657 F. Supp. 1246, 1250 (C.D. Cal. 1987).

"The sweeping language employed by Congress arguably includes states within the class of copyright and trademark infringers." *Woelffer v. Happy States of Am.*, 626 F. Supp. 499, 504 (N.D. Ill. 1985).

96. "[T]he necessary unequivocal expression of congressional intent within the language of the statute . . . is not present. . . ." *BV Eng'g*, 657 F. Supp. at 1250.

"The general authorization for suit in federal court against 'anyone' who infringes a copyright . . . is not the kind of unequivocal statutory language sufficient to abrogate the Eleventh Amendment." *Woelffer*, 626 F. Supp. at 504 (referring to 17 U.S.C. § 501(a) (1982)).

97. "The Eleventh Amendment also does not bar suits against the States when . . . Congress, acting pursuant to

Act was enacted pursuant to Congress' article I powers, the *Anderson* court concluded that there could not have been abrogation, even assuming congressional intent to abrogate.⁹⁸

V. THE ELEVENTH AMENDMENT'S RESTRICTION ON ARTICLE I POWER

A. *The Conflict*

Before any discussion of congressional abrogation of the states' eleventh amendment immunity to copyright infringement actions can begin, a more fundamental question must be resolved. The *Atascadero* opinion implies,⁹⁹ and at least one commentator supports,¹⁰⁰ the theory that the eleventh amendment acts as a restriction upon the power granted to Congress in article I of the Constitution.¹⁰¹ If this theory is correct, then Congress can only abrogate the states' immunity by acting pursuant to its power under the fourteenth amendment, and not under its article I power.

Therefore, a conflict exists between the eleventh amendment and Congress' article I power. The 1976 Act was enacted under Congress' article I powers.¹⁰² If these powers are ineffective in abrogating the states' eleventh amendment immunity, further discussion of congressional abrogation is moot and future cases must focus solely upon an express waiver by the state,¹⁰³ as was the court's analysis in *Anderson*.¹⁰⁴

B. *The Distinction Between Fourteenth Amendment Power and Article I Power*

The *Atascadero* opinion recognized that Congress, pursuant to section 5 of the fourteenth amendment, could abrogate the states' eleventh amendment immunity to suit in federal court.¹⁰⁵ In order to recognize abrogation under the fourteenth

Section 5 of the Fourteenth Amendment, has abrogated the States' Eleventh Amendment immunity. . . ." Richard Anderson Photo. v. Radford Univ., 633 F. Supp. 1154, 1156 (W.D. Va. 1986).

98. "[T]he issue in this case turns not on whether Congress has abrogated the States' immunity, but on whether Virginia has waived it." *Id.* at 1158. *But see* Richard Anderson Photo. v. Brown, 852 F.2d 114, 117 (4th Cir. 1988) (refusing to address the abrogation issue).

99. "[T]he Eleventh Amendment is 'necessarily limited by the enforcement provisions of § 5 of the Fourteenth Amendment. . . .'" *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 238 (1985) (quoting *Fitzpatrick v. Bitzer*, 427 U.S. 445, 456 (1976)).

100. *See Note, Copyright Infringement and the Eleventh Amendment: A Doctrine of Unfair Use?*, 40 VAND. L. REV. 225 (1987).

101. "Congress, acting pursuant to the copyright and patent clause, has no power to unilaterally abrogate a state's eleventh amendment immunity." *Id.* at 265.

In *County of Oneida v. Oneida Indian Nation*, 470 U.S. 226 (1985), the Court was faced with the issue of whether Congress can abrogate the states' eleventh amendment immunity under its article I power. The Court, however, disposed of the case without reaching the eleventh amendment question. *Id.* at 252.

102. When enacting the Copyright Act of 1976, Congress was specifically acting pursuant to its power "[t]o . . . promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

103. "State consent, expressed or implied, remains a necessary ingredient to nullify constitutional immunity in infringement cases." *See Note, supra* note 100, at 265-66.

104. *See supra* notes 70-72 and accompanying text.

105. *See supra* note 99.

amendment, but deny abrogation under article I, there must be some constitutional basis for the distinction.¹⁰⁶

There are two possible bases for distinguishing between Congress' article I power and its power under the fourteenth amendment. The first basis is that the fourteenth amendment repealed some limitation of power that the eleventh amendment placed on Congress. The argument is that the eleventh amendment restricted Congress' article I powers, but that some of these restrictions were subsequently repealed by the fourteenth amendment.¹⁰⁷ This limited repeal of eleventh amendment restrictions would explain why congressional abrogation of eleventh amendment immunity is allowed under the fourteenth amendment, but denied under article I.

The second basis for the distinction between fourteenth amendment power and article I power is that the fourteenth amendment gave Congress an additional grant of power greater than that contemplated under article I.¹⁰⁸ The fourteenth amendment's additional grant of power, therefore, is sufficient to overcome eleventh amendment restrictions, while the lesser grant of power under article I remains subservient to the eleventh amendment.

With these two bases for distinguishing between Congress' fourteenth amendment power and its article I power isolated, it is possible to examine each one individually in order to determine if either is constitutionally sufficient to support such a distinction. If neither basis has constitutional support, then a distinction between Congress' fourteenth amendment power and its article I power cannot stand. A failure to make such a distinction must result in the conclusion that Congress can abrogate the states' eleventh amendment immunity pursuant to any of its plenary grants of power.

C. *The Fourteenth Amendment as a Repeal of Eleventh Amendment Limitations*

In order to conclude that the fourteenth amendment repealed some eleventh amendment limitation on congressional power, an eleventh amendment limitation of congressional power must first be established. If no such limitation exists, there is nothing for the fourteenth amendment to repeal.

An examination of both the text and the history indicate no intention of limiting congressional power by the ratification of the eleventh amendment.¹⁰⁹ The primary motivation behind the eleventh amendment was the desire to overrule the Supreme Court holding in *Chisholm v. Georgia*.¹¹⁰ The desire to overrule *Chisholm* has been recognized by the Supreme Court.¹¹¹ The language of the amendment itself supports

106. See *In re McVey Trucking*, 812 F.2d 311, 315 (7th Cir. 1987).

107. See, e.g., *Fitzpatrick v. Bitzer*, 519 F.2d 559, 569 (2d Cir. 1975), *rev'd on other grounds*, 427 U.S. 445 (1976). See also Note, *Congressional Abrogation of State Sovereign Immunity*, 86 COLUM. L. REV. 1436, 1442 (1986).

108. See, e.g., *Fitzpatrick v. Bitzer*, 427 U.S. 445, 456 (1976). See also Note, *supra* note 107, at 1442.

109. See *McVey Trucking*, 812 F.2d at 317 (discussing the motivation behind the adoption of the eleventh amendment).

110. 2 U.S. (2 Dall.) 419 (1793). In this case, the Court assumed original jurisdiction in a private suit brought by a citizen of South Carolina against the State of Georgia.

111. See *Pennhurst State School and Hosp. v. Halderman*, 465 U.S. 89 (1984) (The Court stated that "the [eleventh] Amendment's language overruled the particular result in *Chisholm*. . ."). *Id.* at 98.

the conclusion that the eleventh amendment was meant to overrule *Chisholm*.¹¹² The framers chose the word "construe"¹¹³ because "they wanted to limit the branch charged with 'construing' the Constitution—the judiciary."¹¹⁴ In addition, the eleventh amendment is specifically addressed to "[t]he Judicial Power of the United States."¹¹⁵ No mention whatsoever is made regarding the effect of the eleventh amendment upon congressional power.

The conclusion to be drawn from the examination of the history and text of the eleventh amendment, as well as Supreme Court precedent, is that the eleventh amendment did not have the effect of placing any limitation on congressional power under article I.¹¹⁶ Because the eleventh amendment never placed any limitation on congressional power, there can be no limitations for the fourteenth amendment to repeal.¹¹⁷ Therefore, an analysis of this basis for making a distinction between Congress' fourteenth amendment power and its article I power does not support making such a distinction.

D. *The Fourteenth Amendment as a Greater Grant of Power Than Article I*

Under the theory that the fourteenth amendment and article I are both plenary grants of congressional power,¹¹⁸ if the fourteenth amendment gave Congress the authority to abrogate the states' eleventh amendment immunity, then Congress must also have that authority under its article I powers.¹¹⁹ The Supreme Court, in *Fitzpatrick v. Bitzer*,¹²⁰ however, saw a distinction between the fourteenth amendment and other grants of plenary power. The Court stated: "Congress may . . . for the purpose of enforcing the provisions of the Fourteenth Amendment, provide for private suits against States, or state officials which are constitutionally impermissible in other contexts."¹²¹ Unfortunately, the Court provided no further guidance as to those situations in which congressional action would be constitutionally impermissible. However, in *Garcia v. San Antonio Metropolitan Transit Authority*,¹²² the Court did discuss Congress' authority under article I to impose an obligation on a state despite sovereign immunity.

112. U.S. CONST. amend. XI, *supra* note 10.

113. *Id.*

114. *McVey Trucking*, 812 F.2d at 317.

115. U.S. CONST. amend. XI, *supra* note 10.

116. *See, e.g., Atascadero State Hosp. v. Scanlon*, 473 U.S. 234 (1985). Justice Brennan, arguing in dissent, stated: The language of the Eleventh Amendment, its legislative history, and the attendant historic circumstances all strongly suggest that the Amendment was intended to remedy an interpretation of the Constitution that would have had the . . . diversity clauses of Article III abrogating the state law of sovereign immunity on state-law causes of action brought in federal courts.

Id. at 289 (Brennan, J., dissenting).

117. *See McVey Trucking*, 812 F.2d at 316–19 (specifically rejecting the "repeal" analysis); *Fitzpatrick v. Bitzer*, 519 F.2d 559, 569 (2d Cir. 1975) (rejecting the theory that the fourteenth amendment modified the eleventh amendment).

118. "[B]oth Article I and the Fourteenth Amendment are plenary grants of power. . . ." *McVey Trucking*, 812 F.2d at 319.

119. *Id.* at 319.

120. 427 U.S. 445 (1976).

121. *Id.* at 456.

122. 469 U.S. 528 (1985). Although the case dealt with the tenth amendment, the underlying logic concerning abrogation of state sovereignty applies equally to abrogation of immunity under the eleventh amendment.

The Court in *Garcia* recognized that the states retain some sovereign immunity, but not total immunity. The states, the Court noted, retain immunity “only to the extent that the Constitution has not divested them of their original powers and transferred those powers to the Federal Government.”¹²³ The Court further stated that the “states remain sovereign as to all powers not vested in Congress or denied them by the Constitution.”¹²⁴ The test under *Garcia* for congressional power to abrogate the states’ immunity, therefore, becomes “simply whether the Constitution has ‘divested [the states] of their original powers and transferred those powers to the Federal Government.’”¹²⁵ Because “the Constitution does not carve out express elements of state sovereign immunity that Congress may not employ its delegated powers to displace,”¹²⁶ once Congress has been delegated a specific power, the states may not escape the exercise of that power by claiming sovereign immunity. This conclusion is in accord with a previous statement by the Court: “By empowering Congress to regulate . . . , the States necessarily surrendered any portion of their sovereignty that would stand in the way of such regulation.”¹²⁷

The Court in *Garcia* did express concern over federal intrusion into state sovereignty.¹²⁸ Nevertheless, the Court ultimately concluded that the “[s]tate[s]’ sovereign interests . . . are more properly protected by the procedural safeguards inherent in the structure of the federal system than by judicially created limitations on federal power.”¹²⁹ The language chosen by the Court indicates that the Court considers the *political system* as the primary method available to the states to limit federal intrusion into state sovereignty, not the judiciary. In addition, lower courts are directed to refrain from setting artificial limits on congressional power in the interest of state sovereignty.

In light of the *Garcia* test, the theory that the fourteenth amendment granted Congress greater power than article I cannot stand. Congress may, when acting pursuant to its article I power, “exercise [that power],” even though it will “interfere with the laws, or even the Constitution of the State.”¹³⁰ Therefore, a distinction between the fourteenth amendment power and article I power cannot be supported by the theory that the fourteenth amendment was a greater grant of congressional power than article I.¹³¹

123. *Id.* at 549.

124. *Id.* at 550. The Court also recognized that “[s]ection 8 of [article I] works as [a] . . . sharp contraction of state sovereignty by authorizing Congress to exercise a wide range of legislative powers. . . .” *Id.* at 548.

125. *In re McVey Trucking*, 812 F.2d 311, 320 (7th Cir. 1987) (quoting *Garcia v. San Antonio Metro. Transp. Auth.*, 469 U.S. 528, 549 (1985)).

126. *Garcia*, 469 U.S. at 550.

127. *Parden v. Terminal Ry.*, 377 U.S. 184, 192 (1964).

128. “[T]he States occupy a special position in our constitutional system. . . .” *Garcia*, 469 U.S. at 547.

129. *Id.* at 552. The Court was also influenced by the inherent limitations placed on Congress’ article I power due to the delegated nature of that power. *Id.* at 550.

130. 2 *Annals of Cong.* 1897 (1791) (quoting J. Madison).

131. “[T]he Constitution of the United States, with the several amendments thereof, must be regarded as one instrument, all of whose provisions are to be deemed of equal validity.” *Prout v. Starr*, 188 U.S. 537, 543 (1903).

In a case decided shortly after *Atascadero*, the Court refused to limit the power of Congress to abrogate the eleventh amendment immunity, stating: “Congress [can] . . . pursuant to a *valid exercise of power* . . . abrogate immunity.” *Green v. Mansour*, 474 U.S. 64, 68 (1985) (emphasis added).

E. *The Effect of the Eleventh Amendment Upon Judicial Power*

Having determined that there is no basis for distinguishing between Congress' article I power and its power under the fourteenth amendment, the possible limitations that the eleventh amendment may have placed upon the federal judiciary must now be examined. The examination is necessary because even if Congress has the power to abrogate the states' eleventh amendment immunity, the power is of little use if the federal courts are unable to enforce congressional acts which may impinge on the states' sovereignty.

Such a broad reading of the eleventh amendment, the effect of which would be to totally prohibit the federal courts from enforcing congressional acts that might conflict with state sovereignty, is not warranted.¹³² The eleventh amendment has not been interpreted as preventing a federal court from issuing enforceable orders that affect a sovereign state.¹³³ In addition, when acting under the fourteenth amendment, Congress can require the federal courts to impose monetary damages upon an unconsenting sovereign state.¹³⁴ Because the fourteenth amendment makes no express grant of additional power to the judiciary,¹³⁵ the power of the federal courts to enforce congressional acts under the fourteenth amendment must be implied.¹³⁶ As discussed above, no constitutional basis can be supported for a distinction between Congress' fourteenth amendment power and its power under article I. Therefore, there can be no constitutional basis for implying judicial power under the fourteenth amendment and refusing to imply judicial power under article I.¹³⁷

The conclusion to be drawn from an analysis of congressional ability to abrogate the states' eleventh amendment immunity, either under the fourteenth amendment or under article I, is that the eleventh amendment does not prevent Congress from abrogating the states' eleventh amendment immunity when Congress acts pursuant to its article I powers. Further, when Congress has so abrogated the states' immunity, the eleventh amendment does not prevent the federal courts from enforcing the intent of Congress against an unconsenting state.¹³⁸

The lack of a distinction between Congress' article I power and its power under the fourteenth amendment is particularly evident in the patent and copyright area. The Court has stated:

[U]nder the Constitution, Congress has power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,' and to make all laws which may be necessary and proper for carrying that express power into execution . . .

United States v. Duell, 172 U.S. 576, 583 (1899) (quoting the Patent and Copyright Clause, *supra* note 1).

132. See *In re McVey Trucking*, 812 F.2d 311, 321-22 (7th Cir. 1987).

133. See, e.g., *Florida Dept. of State v. Treasure Salvors, Inc.*, 458 U.S. 670 (1982) (federal courts may enjoin a state where the state's officers have acted without state authority); *Gardner v. New Jersey*, 329 U.S. 565 (1947) (federal bankruptcy court could void a tax lien held by the state); *Ex parte Young*, 209 U.S. 123 (1908) (federal courts may enjoin a state from violating the constitutional rights of its citizens).

134. See, e.g., *Fitzpatrick v. Bitzer*, 427 U.S. 445, 456-57 (1976).

135. "The Congress shall have the power to enforce, by appropriate legislation . . ." U.S. CONST. amend. XIV, § 5 (emphasis added). See *supra* note 70.

136. *McVey Trucking*, 812 F.2d at 323.

137. "If Congress acting within its Article I or other powers creates a legal right and remedy, . . . then Congress may entrust adjudication of claims based on the newly created right to the federal courts—even if the defendant is a State." *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 290 (1985) (Brennan, J., dissenting).

138. *Id.*

VI. CONGRESSIONAL ABROGATION OF ELEVENTH AMENDMENT IMMUNITY

A. *The Atascadero Test*

Prior to the *Atascadero* opinion, the normal method of interpreting congressional intent, when not expressly stated on the face of the statute, was to look at the statute together with its legislative history.¹³⁹ However, the Court's statement in *Atascadero* that "Congress must express its intention to abrogate the Eleventh Amendment in unmistakable language in the statute itself,"¹⁴⁰ indicates that the lower courts are not permitted to look beyond the face of the statute itself for guidance.

A strict reading of this "face of the statute" language would prohibit the lower courts from seeking any guidance as to the intent of Congress from a statute's legislative history, or the opinions of other tribunals.¹⁴¹ A lower court *must* dismiss an action against a state actor if the language of the particular statute in question could be construed as having more than one possible interpretation.¹⁴² As an unchallengeable defense, a guilty state need only allude to a statute's lack of "unmistakability" in order to escape the statute's reach. As a result, it will be extremely difficult for Congress to abrogate the states' eleventh amendment immunity.¹⁴³ In addition, the federal courts would be put in the difficult position of *ignoring* the clear statutory intentions of Congress, as expressed in the legislative history of the act, because of less than clear language.¹⁴⁴ Such a result is undesirable, especially in a democratic system in which the actual language of a statute is more an exercise in the art of compromise than it is a test of linguistic skill.

Not only is a strict "face of the statute" interpretation of *Atascadero* an undesirable result, it is not, as suggested by some courts,¹⁴⁵ compelled by the language of the opinion. A closer reading of the opinion highlights Justice Powell's underlying emphasis on certainty. Rather than mandating a specific statutory construction method, the opinion instead emphasizes that the federal courts must be "certain of Congress' intent before finding that federal law overrides the guarantees of the Eleventh Amendment."¹⁴⁶ It was Justice Powell's belief that by requiring Congress to express its intention in the statute itself, the courts could "ensure such certainty."¹⁴⁷

In addition, Justice Powell was concerned with the expansion of the jurisdiction of the federal judiciary. Justice Powell stated that it was "appropriate" for the federal

139. *McVey Trucking*, 812 F.2d at 323.

140. *Atascadero*, 473 U.S. at 243.

141. *McVey Trucking*, 812 F.2d at 324.

142. *Id.*

143. *Atascadero*, 473 U.S. at 254-55 (Brennan, J., dissenting).

144. *Id.*

145. See, e.g., *BV Eng'g v. University of Cal.*, Los Angeles, 657 F. Supp. 1246, 1250 (C.D. Cal. 1987); *Richard Anderson Photo. v. Radford Univ.*, 633 F. Supp. 1154, 1159 (W.D. Va. 1986), *aff'd sub nom.*, *Richard Anderson Photo. v. Brown*, 852 F.2d 114 (4th Cir. 1988).

146. *Atascadero*, 473 U.S. at 243.

147. *Id.*

courts to rely "only on the clearest intentions . . . that Congress has enhanced our power."¹⁴⁸

The *Atascadero* opinion, therefore, did not mandate a specific form of statutory construction. Rather, it used a particular form of statutory construction as *prima facie* evidence of congressional intent. If the congressional intent behind a statute is evidenced in such a way that "ensure[s] . . . certainty,"¹⁴⁹ then express language on the face of the statute is not required.¹⁵⁰ The federal courts can, therefore, permissibly look beyond the four corners of the statute itself in order to determine Congress' intent to abrogate the states' eleventh amendment immunity.¹⁵¹ Looking beyond the statute itself is in accord with the Supreme Court practice of relying upon legislative history when interpreting a statute,¹⁵² and with a perceived retreat on this subject by the Court in an opinion issued subsequent to *Atascadero*, in which the Court made no mention of a "face of the statute" requirement.¹⁵³

Finally, it cannot be overlooked that the overall goal of the federal courts when interpreting statutes is to "give effect to the intentions of Congress."¹⁵⁴ Failure to look to a statute's legislative history can inhibit this goal,¹⁵⁵ even when the legislative history shows evidence of mixed motivations. While express language in the statute itself may provide the Court's requisite certainty, the federal courts should not hesitate to look beyond the face of the statute for guidance in its interpretation when the language of the statute itself cannot ensure certainty. If the court can be certain of Congress' intent, whether by reading the statute itself, or by an expression of intent in the statute's legislative history, the court is "duty-bound to give effect to that desire."¹⁵⁶

B. *The Search for Certainty*

In the most recent cases of copyright infringement brought against state actors, the lower federal courts have *refused* to look beyond the face of the 1976 Act in order

148. *Id.*

149. *Id.*

150. *In re McVey Trucking*, 812 F.2d 311, 324-25 (7th Cir. 1987).

151. *Id.*

152. In *Quern v. Jordan*, 440 U.S. 332 (1979), the Court looked first to the language of the statute. Having found no explicit language indicating an intent to abrogate the state's immunity, the Court then looked to the statute's legislative history. An important factor in the Court's analysis was a lack of any "history which focuses directly on the question of state liability. . . ." *Id.* at 345.

Similarly, the legislative history of the statute in question was heavily relied upon by the Court in *Hutto v. Finney*, 437 U.S. 678 (1978). Stating that the "legislative history [was] . . . plain," the Court was certain of Congress' intent to abrogate the state's immunity. *Id.* at 694.

153. In *Green v. Mansour*, 474 U.S. 64 (1985), the Court stated that the eleventh amendment prevents the states from being sued in federal courts unless "they consent to [suit] in unequivocal terms or unless Congress, pursuant to a valid exercise of power, unequivocally expresses its intent to abrogate immunity." *Id.* at 68.

The language in *Green* makes no mention of the *Atascadero* desire that congressional intent be expressed on the face of the statute in order to be effective. While this could be interpreted as a retreat by the Court in *Green* from the strict *Atascadero* language, it also further confirms the fact that the Court is emphasizing certainty rather than a method of statutory construction.

154. *United States v. American Trucking*, 310 U.S. 534, 542 (1940).

155. "If the Court . . . fails to implement the plain intent of Congress, it upsets another fundamental constitutional balance: the balance between the legislature and the judiciary." Note, *supra* note 107, at 1448.

156. *In re McVey Trucking*, 812 F.2d 311, 326 (7th Cir. 1987).

to ascertain the true intentions of Congress. This refusal to do so was the result of an overly restrictive reading of the *Atascadero* opinion.¹⁵⁷ While the language of the 1976 Act does not contain any specific phrase indicating that Congress meant to include the states within the 1976 Act's reach, failure to look at the statute as a whole results in an incorrect conclusion of congressional intent.

An examination of the entire body of the 1976 Act uncovers numerous express exemptions of state activities.¹⁵⁸ Although some of these express exemptions refer to the rather generic term "governmental body,"¹⁵⁹ at least two exemptions specifically address "any State."¹⁶⁰ If Congress had thought it necessary to carve out exemptions for state actors, it could only have been because Congress meant the individual states to be within reach of the 1976 Act.¹⁶¹ While Congress stopped short of specifically stating that the individual states were subject to the 1976 Act, logic compels the conclusion that Congress wanted to make the states subject to the 1976 Act and thought it was doing so. The lower courts' insistence on a specific, undefined phrase or catchword is unwarranted in light of the clear, express signal of congressional intent on the face of the 1976 Act. In fact, the Ninth Circuit found this very argument "compelling," yet still felt "constrained by the [*Atascadero*] mandate."¹⁶²

In addition to clear language of congressional intent on the face of the 1976 Act itself,¹⁶³ the legislative history is filled with examples indicating that Congress intended the 1976 Act to reach the states.¹⁶⁴ In particular, specific exemptions for state fairs and state educational activities were debated on the floor of the House.¹⁶⁵ The legislative history clearly indicates that the specific state exemptions were not accidental. Congress thought these state exemptions were necessary so that the states could escape liability for copyright infringement. Logic compels the conclusion that Congress, at the very least, thought that the states were subject to the 1976 Act.

Despite the clear indications of congressional intent in both the statute itself, and in the legislative history of the 1976 Act, the lower courts' reading of the *Atascadero* opinion forced them to dismiss the actions before them. The lower courts' willingness to uphold the states' eleventh amendment immunity defense indicates a failure to look

157. See cases cited *supra* notes 56-94 and accompanying text.

158. See, e.g., 17 U.S.C. §§ 107, 110(2), 110(6), 110(8), 111(a)(4), 112(b)(3), 112(c), 112(d), 118(d)(3), 601(b)(3), 602(a) (1982 & Supp. IV 1986).

159. See, e.g., 17 U.S.C. § 107 (1982) (generally describing "classroom use" as a noninfringing fair use); 17 U.S.C. § 110(2) (1982) (exempting performance of nondramatic literal or musical works when part of the "instructional activities of a governmental body"); 17 U.S.C. § 110(6) (1982) (exempting performance of nondramatic musical works by a "governmental body"); 17 U.S.C. § 111(a)(4) (1982 & Supp. IV 1986) (exempting secondary transmissions by a "governmental body"); 17 U.S.C. § 112(b)(3) (1982) (exempting recordings made by a "governmental body"); 17 U.S.C. § 118(d)(3) (1982) (exempting reproductions made by a "governmental body").

160. 17 U.S.C. § 601(b)(3) (1982) (exempting importation of copyrighted works by "any State or political subdivision of a State"); 17 U.S.C. § 602(a) (1982) (exempting "any State or political subdivision of a State").

161. See Note, *supra* note 100, at 261.

162. *BV Eng'g v. University of Cal.*, Los Angeles, 858 F.2d 1394, 1400 (9th Cir. 1988).

163. See *supra* notes 158-59.

164. See, e.g., 113 CONG. REC. 8590 (1967) (remarks of Rep. Nelson discussing the need for an exemption for state and county fairs); 113 CONG. REC. 8612 (1967) (remarks of Rep. Kastenmeier discussing an exemption for state and local school systems); 113 CONG. REC. 8617 (1967) (remarks of Rep. Morris discussing the discriminating effect a proposed amendment to the 1909 Act would have on geographically smaller states).

165. *Id.*

at the 1976 Act as a whole, and applies an overly restrictive interpretation of *Atascadero*.

VII. FEDERAL PREEMPTION

In *Atascadero*, the Court wished to buttress the sovereignty of the states against the gradual encroachment of federal power. Instead, the lower courts have interpreted *Atascadero* so as to remove any obstacles that stood between a federally protected property right and the theft of that property by state actors.

Unlike other federal legislation that either gives rise to both federal and state causes of action,¹⁶⁶ or a federal cause of action that exists in conjunction with a state cause of action,¹⁶⁷ a copyright owner has only one forum available, the federal courts.¹⁶⁸ If the federal courts refuse to entertain a copyright infringement suit, there is no alternative court to which the copyright owner can plead for relief. The Ninth Circuit acknowledged this unfair result, stating: "We recognize that our holding will allow states to violate the federal copyright laws with virtual impunity."¹⁶⁹

Compounding the copyright owner's difficulties is the fact that the 1976 Act preempts any action predicated on state copyright law.¹⁷⁰ Although the eleventh amendment does not bar suits against a state in that state's courts, there no longer is any substantive state law cause of action upon which relief can be granted.¹⁷¹

The result of this unique combination of circumstances is that the copyright owner must go to federal court to seek relief. If the federal courts refuse to entertain infringement suits against state actors, the copyright owner has no way to enforce a property right granted by Congress and specifically authorized by the Constitution.¹⁷² To deny an injured party a remedy is unfair, especially when the denial is caused by a rule of statutory construction that the federal courts have imposed upon themselves.¹⁷³ The Court has recognized that reading a "sovereign immunity exception" into a statute that preempted suits in state courts would result in a "right without a remedy."¹⁷⁴ The Court was, therefore, "unwilling to conclude that Congress intended so pointless and frustrating a result."¹⁷⁵

166. See, e.g., *Flagship Real Estate v. Flagship Banks*, 374 So. 2d 1020, 1021 (Fla. Dist. Ct. App. 1979) (The state court found concurrent jurisdiction with the federal courts in a trademark infringement action.).

167. See, e.g., 17 U.S.C. § 301(b) (1982 & Supp. IV 1986) (allowing state copyright actions that are not within the subject matter of federal copyright law).

168. See 28 U.S.C. § 1338(a) (1982 & Supp. IV 1986) (conferring original jurisdiction of copyright actions in the federal courts and specifically excluding state court jurisdiction). See also 17 U.S.C. § 301(a) (1982 & Supp. IV 1986) (preempting state copyright protection).

169. *BV Eng'g v. University of Cal.*, Los Angeles, 858 F.2d 1394, 1400 (9th Cir. 1988).

170. See 17 U.S.C. § 301(a) (1982 & Supp. IV 1986).

171. See, e.g., *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 (1964) ("[The patent and copyright] laws, like other laws of the United States enacted pursuant to constitutional authority, are the supreme law of the land."). See also 17 U.S.C. § 301(a) (1982 & Supp. IV 1986) (stating that the federal copyright laws preempt both common law and state copyright law.). But see 17 U.S.C. § 301(b) (1982) (allowing certain forms of state copyright protection).

172. U.S. CONST. art. I, § 8, cl. 8.

173. "[T]he Court has put in place special rules of statutory draftsmanship that Congress must obey before the Court will accord recognition to its act." *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 253-54 (1985) (Brennan, J., dissenting).

174. *Parden v. Terminal Ry.*, 377 U.S. 184, 190 (1964).

175. *Id.*

VIII. CONCLUSION

Despite an inference to the contrary in *Atascadero*, there is no basis for a distinction between Congress' power to abrogate the states' eleventh amendment immunity under the fourteenth amendment and Congress' power to abrogate the states' immunity under article I. Before entertaining any suit against an unconsenting state, however, the federal courts must be certain of Congress' intent to hold the state answerable in federal court. In order to determine congressional intent, the federal courts are not limited to exploring the face of the statute itself for unequivocal language, but must also look at the intent of the statute as a whole, as well as the statute's legislative history.

The recent line of federal court decisions holding that an action for copyright infringement cannot be maintained against a state actor apply an overly restrictive interpretation of the *Atascadero* opinion that serves to frustrate the clear intention of Congress to subject the individual states to the provisions of the Copyright Act of 1976. The lower courts, rather than looking at the 1976 Act as a whole and considering its legislative history, adopt a myopic rule of statutory construction. By their blind adherence to a self-imposed restriction, the lower courts are forced to ignore any indications of congressional intent other than an undefined, unequivocal expression. As a result, the clear intentions of Congress are being denied.

While the lower courts view their self-imposed restriction as championing the sovereignty of the states, the fear of federal encroachment into state sovereignty is misplaced as applied to the issue of copyright infringement. The power to issue letters of copyright and protect the copyright owners has always been a federal power. As a power vested in Congress, the states retain no sovereignty with respect to copyrights. For the lower courts to now grant the states sovereignty ignores the Constitution, the history of the eleventh amendment, and the express will of Congress.

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